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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/029,108	12/21/2001	John Gilbert	CVZ-005	3364

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LAHIVE & COCKFIELD
28 STATE STREET
BOSTON, MA 02109

EXAMINER

LUDLOW, JAN M

ART UNIT	PAPER NUMBER
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1743

DATE MAILED: 12/01/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/029,108

Applicant(s)

GILBERT, JOHN

Examiner

Jan M. Ludlow

Art Unit

1743

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 and 40-49 is/are pending in the application.
- 4a) Of the above claim(s) 50-53 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 9, 11, 13, 16, 40-43 and 49 is/are rejected.
- 7) ☒ Claim(s) 7, 8, 10, 12, 14, 15 and 44-48 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 December 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

Art Unit: 1743

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-16, 40-49, drawn to a sample dispensing system having a pin with both sample filling channel and ejection nozzle in the tip, classified in class 422, subclass 100.

II-III. Cancelled claims.

IV. Claims 50-52, drawn to a sample dispensing system having a pin with a U shaped channel, classified in class 422, subclass 100.

V. Claim 53, drawn to a sample dispensing system with a holder, classified in class 422, subclass 100.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions [I, V] and IV are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, each invention has separate utility such as a printing pin with different characteristics. See MPEP § 806.05(d).

3. Inventions V and I are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the combination does not require

Art Unit: 1743

the filling channel and ejection nozzle formed in the tip. The subcombination has separate utility such as a manual, individual printing tip.

4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper. In particular, the inventions have different features requiring different search terms in electronic searching.

5. Newly submitted claims 50-53 are directed to an invention that is independent or distinct from the invention originally claimed for the above reasons.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 50-53 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1, 4, 9, 40, 41-43, 49 are rejected under 35 U.S.C. 102(b) as being anticipated by Martinsky.

Art Unit: 1743

Martinsky teaches a holder 10 holding pins 60 with a tip 20 holding chamber 40 and channel which is used for both filling and ejecting samples (e.g., Fig. 4). A motion control system, such as a computer-controlled robot, (instant actuator) is used to move the pins in contact with a substrate to eject sample (col. 7, 30-35, col. 8, lines 13-50).

8. Claims 2-3, 5-6, 11, 13, 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Martinsky.

Martinsky fails to teach the instant dimensions or electrical connections.

It would have been obvious to optimize the dimensions of the device of Martinsky in order to deliver desired volumes (col. 6, lines 45-68). It would have been further obvious to control the robot using electronic circuitry as was known in the art.

9. Claims 7-8, 10, 12, 14-15, 44-48 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The prior art fails to teach or suggest the filling and dispensing channels as separate structures both in the tip of a dispensing pin; the filling channel extending below the dispensing channel, both in the tip of a dispensing pin; or an additional channel coupled to the filling channel and formed by a second pin in proximity to the first pin with the channels formed as claimed.

10. Applicant's arguments with respect to claims 1-16, 40-49 have been considered but are moot in view of the new ground(s) of rejection.

Art Unit: 1743

The examiner notes that the initial examination interpreted the claims as having separate filling and dispensing channels, and this distinction being made only in claim 8 was not noted initially.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jan M. Ludlow whose telephone number is (703) 308-4039. The examiner can normally be reached on Monday-Thursday, 11:30 am - 8:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill A. Warden can be reached on (703) 308-4037. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9310.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.



Jan M. Ludlow
Primary Examiner
Art Unit 1743

jml
December 1, 2003